



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/803,806

03/17/2004

James Marggraff

020824-004610US

5601

41066

7590

04/17/2008

MURABITO, HAO & BARNES, LLP  
TWO NORTH MARKET STREET, THIRD FLOOR  
SAN JOSE, CA 95113

EXAMINER

GISHNOCK, NIKOLAI A

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

04/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/803,806	<b>Applicant(s)</b> MARGGRAFF ET AL.	
	<b>Examiner</b> Nikolai A. Gishnock	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

In response to Applicant's remarks filed 1/24/2008, claims 1-36 are cancelled. Claims 37-72 are pending.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 37-40, 49-52, & 61-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverbrook et al. (US 6,678,499 B1), hereinafter known as Silverbrook.

3. Silverbrook discloses a computing device for providing instructional response, and a method and computer readable media for implementing a method, the media having computer readable code which when executed by a processor of a computing device cause the computing device to perform a method for providing instructional response (Instructional responses are further understood to be answers to questions, Silverbrook teaches a user responding to questions during an examination, 4:40-5:5; also at 45:61-48:6), comprising: an input device for accepting an unstructured user input (system includes a sensing device to convey data from the form to the computer system and to contribute additional data. The sensing device is configured as a pen, which is designed to be able to physically mark the interactive form as well as to

Art Unit: 3714

selectively enable the coded data from the form to be read and transmitted to the computer system. The coded data then provides control information, configured such that designation thereof by a user causes instructions to be applied to the software running on the computer system or network, 3:58-4:2; unstructured user input is understood as such: A free response examination paper allows the input of numeric expressions, values or text. The system may employ text conversion to allow the system to evaluate the response automatically, and unrecognized input can be routed to an examiner or administrator, 4:66-5:3) by reading a plurality of substantially invisible codes, wherein said plurality of substantially invisible codes are printed on a surface (the form is disposed on sheet material such as paper or the like which has the coded data printed on it and which allows interaction with the computer system. The coded data is detectable preferably, but not exclusively, outside the visible spectrum, thereby enabling it to be machine-readable but substantially invisible to the human eye, 3:45-57); a processor for processing said user input (The pen controller chip includes a controlling processor. {The} bus enables the exchange of data between components of the controller chip, 40:51-54), wherein said processing comprises: recognizing a plurality of print elements associated with said plurality of substantially invisible codes (The controlling processor captures and decodes location data from tags from the surface via the image sensor, 40:62-64); and in response to said recognizing, determining said instructional response (the present invention provides a method of enabling examinations, including the steps of: providing a user involved in an examination exercise with an exercise form containing coded data indicative of an identity of the exercise form and of at least one reference point of the exercise form; receiving, in a computer system, response data from a sensing device operable by said user, said data regarding the identity of the exercise form and a position of the sensing device relative to the exercise form, the sensing device, when placed in an operative position relative to the exercise form, sensing

Art Unit: 3714

the coded data and providing said response data from said coded data, 2:13-25; also, for each examination question, an examinee may give an answer. Each multiple-choice answer contains the chosen option number and the time the answer was written. Each essay answer has the essay content. The essay answer is handwritten by the user and is stored as digital ink, and optionally the writing may be converted to text using handwriting recognition. Each answer may have associated with it a score and a comment, 46:31-39); and an output device (net page printer, 41:51-42:52) for outputting said instructional response (Multiple choice questions can be automatically marked by the examination application. If a completed examination is printed by a marker, extra fields can optionally be printed for essay style questions to allow the marker to enter the score and comments against the answer, 48:1-6) [Claims 37, 49, & 61].

4. Silverbrook discloses wherein the unstructured user input comprises a print element created by the user on said surface (the sensing device is configured as a pen, which is designed to be able to physically mark the interactive form as well as to selectively enable the coded data from the form to be read and transmitted to the computer system, 3:58-4:2; also, the netpage pen operates both as a normal marking ink pen and as a non-marking stylus, 41-43) [Claims 38, 50, & 62].

5. Silverbrook discloses a writing element (an ink pen cartridge with nib and a stylus with stylus nib are mounted side by side within the housing. Either the ink cartridge nib or the stylus nib can be brought forward through open end of the metal end piece, by rotation of the pen top, 39:36-42) [Claims 39, 51, & 63].

6. Silverbrook discloses a stylus having an optical detector for detecting said plurality of substantially invisible codes printed on said surface, and a processor coupled to the optical detector (A second flex PCB, is mounted on an electronics chassis which sits within the housing. The second flex PCB mounts an infrared LED for providing infrared radiation for

Art Unit: 3714

projection onto the surface. An image sensor is provided mounted on the second flex PCB for receiving-reflected radiation from the surface. The second flex PCB also mounts a radio frequency chip, which includes an RF transmitter and RF receiver, and a controller chip for controlling operation of the pen. An optics block sits within the cover, and projects an infrared beam onto the surface and receives images onto the image sensor, 39:60-40:4), and a memory unit (Flash memory and a 512 KB DRAM are also included, 40:51-54) comprising code for audio outputs corresponding to the print element (A document instance corresponds to a formatted document. It consists of a set of page instances, each of which corresponds to a page description of the formatted document. Each page instance describes a single unique printed netpage. A page instance has a background field, which is used to record any digital ink captured on the page, which does not apply to a specific input element. In the preferred form of the invention, a tag map is associated with each page instance to allow tags on the page to be translated into locations on the page. A page instance consists of a set of terminal element instances. Each formatted element has a spatial extent or zone on the page. This defines the active area of input elements such as hyperlinks and input fields. A terminal element can be a static element, {etc.} A static element can be an audio clip element with an associated audio clip object, {etc.}, 14:43-15:15; it is understood that the controlling processor captures and decodes {pen} location data from tags from the {page instance's} surface via the image sensor, 40:62-64, using the flash and DRAM memory unit, where the terminal element's location is associated with a tag, and the terminal element is associated with an audio clip object) [Claims 40, 52, & 64].

Art Unit: 3714

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 41-48, 53-60, & 65-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook, in view of Nagasaki et al. (US 5,896,403), hereinafter known as Nagasaki.

10. Silverbrook teaches all the features of claims 37-40, 49-52, & 61-64 as demonstrated above. Silverbrook teaches wherein the plurality of substantially invisible codes at a plurality of positions is operable to determine a location of a plurality of print elements on the surface (3:58-4:2) [Claims 45, 57, & 69]. Silverbrook teaches wherein the unstructured user input is a non-keyboard user input (handwritten input, 4:66-5:3; also at 46:31-39) [Claims 46, 58, & 70]. Silverbrook teaches a writing device (39:36-42) [Claims 48, 60, & 72], and wherein a surface is a writing surface (paper, 3:45-57) [Claims 44, 56, & 68]. Silverbrook teaches wherein the processor, input device, and writing device form a housing having a pen-like appearance (39:10-40:23) [Claims 48, 60, & 72].

Art Unit: 3714

11. What Silverbrook fails to teach is wherein the output device is an audio output device [Claims 41, 53, & 65], wherein the output device is configured to generate an audio output related to a user created print element on said surface [Claims 44, 56, & 68], and wherein the output device, along with the elements of Silverbrook, form a housing having a pen-like appearance [Claims 48, 60, & 72]. However, Nagasaki teaches where sound data recorded on a paper sheet is read by a pen type information reproducing apparatus. The user traces the dot code with the pen type information reproducing apparatus to detect the dot code. Upon conversion of the dot code into a sound, the user can hear the sound through a speech output device such as an earphone. The overall information reproducing apparatus of this embodiment is housed in a portable pen type housing. Nagasaki further teaches a loudspeaker incorporated in the housing (9:60-10:8, see also Figures 2B & 3). The loudspeaker for reproducing and outputting sound information, based on a code printed on paper, as taught by Nagasaki, would be incorporated into the pen of Silverbrook for generating and outputting the audio clip tags associated with a user's writing, as taught by Silverbrook. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have an audio output device form a housing having a pen-like appearance, configured to generate an audio output related to a user created print element on said surface, as taught by Nagasaki, included in the pen housing having a processor, input device, and writing device, as in Silverbrook, wherein the writing surface has a plurality of substantially invisible codes on a paper writing surface, at a plurality of positions for determining is operable to determine a location of a plurality of print elements on the surface, in order to allow inexpensive, large-capacity recording and repetitive reproduction of multimedia information, including audio information, to be easily transmitted by a paper-printing apparatus, such as a fax machine or printer [Claims 41, 44, 48, 53, 56, 60, 65, 68, & 72].



Art Unit: 3714

12. What Silverbrook further fails to teach is wherein a task is audibly presented to the user by the audio output device [Claims 42, 54, & 66], wherein the instructional response is an audio instructional response presented to the user by the audio output device [Claims 43, 55, & 67], and wherein the instructional response relates to a task presented to the user [Claims 47, 59, & 71]. However, Nagasaki teaches various applications of recording of audio information including teaching materials for foreign languages and language dictionaries, repair manuals, books and magazines such as picture books, guide books for travelers, fax (voice & fax) operation instructions, electronic blackboards, etc. (12:58-13:5). These various applications taught by Nagasaki are understood to audibly present a user with an instructional response in the form of a task, and would be used with the user input device of Silverbrook for accepting an unstructured written user input, recognizing a plurality of print elements, determining an instructional response, and outputting the response in an audio format. Nagasaki further teaches audio codes printed on a double-coated adhesive tape, such as a label, which peels off and is stuck on the lower surface of a roll of paper (12:58-13:5), wherein machine-readable codes are recorded in transparent ink on the upper surface of the paper (14:18-67). A required portion of the paper that can be cut and stuck on various things is understood to be a sticker. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the audio tag information in the pen of Silverbrook to convey an instructional response in the form of a task to a user, as taught by Nagasaki, in order to provide instructions to a user which can be faxed, listened to, and optionally read [Claims 42, 43, 47, 54, 55, 59, 66, 67, & 71].

***Response to Arguments***

13. Applicant's arguments filed 1/24/2008 have been fully considered but they are not persuasive.

14. Applicant states at pages 10-11 that Silverbrook fails to teach or suggest a computing device determining the instructional response, as claimed, because Silverbrook discloses that after answers are provided by the examinee, the marker may enter the score and provide comments by writing on the optional fields that are provided. As such, it is the marker that provides comments, as disclosed by Silverbrook, and not a computing device, as claimed. However, Examiner understands an instructional response to be a choice selected by the examinee. Nothing in the instant claims requires an instructional response to be the correct answer known to a grader or marker. Silverbrook clearly discloses that the examinee may give an answer to a multiple choice question or essay (46:31-35). Thus, Silverbrook anticipates the claim limitation as interpreted. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, Silverbrook clearly discloses where multiple choice questions can be automatically marked by the examination application (48:1-6). A completed examination is printed by a marker for scoring and commenting on essay questions. *Id.* Thus, Silverbrook even further discloses a computing device determining the instructional response, as claimed. Thus, Applicant's arguments are further not persuasive.

15. Applicant further states at page 11 that Silverbrook fails to either teach or suggest an output device for outputting the instructional response, as claimed, because Silverbrook discloses that the examination may be printed and thereafter the marker may provide comments and scores, and that the output device is not outputting any instructional response, but rather outputting the exam with its answer from the user such that a marker at a later time can provide

Art Unit: 3714

comments. However, as demonstrated above, Silverbrook discloses where instructional responses are given by an examinee in answer to a multiple choice question or essay (46:31-35), and where a completed examination {completed by the examinee} is printed by a marker (48:1-6). The completed examination, comprising the instructional responses to the multiple-choice questions of the examinee, is printed by a marker. Thus, Silverbrook clearly discloses an output device for outputting the instructional response, as claimed, and hence, Applicant's argument is not persuasive.

16. Applicant further states at page 12 that Silverbrook fails to teach detecting a plurality of substantially invisible codes printed on the surface, as claimed, but rather discloses that an infrared LED that provides infrared radiation for projection onto the surface where an image sensor receives the reflected radiation from the surface (Silverbrook, col. 39, lines 62-65), and thus teaches where the image sensor receives the reflection of an image that is visible.

However, Applicant's Specification at page 5, paragraph 0028: *The page in the book can have substantially invisible codes on them [sic]. The codes are "substantially invisible" to the eye of the user, and these codes correspond to print elements such as letters, numbers, and pictures, on the page or correspond to the absolute or relative locations of the print elements on the page. "Substantially invisible" also includes codes that are completely or slightly invisible to the user's eye during normal use even though the printing (e.g., printed dots) making up the codes might be seen by the user. For example, in a dot pattern, differences in dot size are not easily discernable to the user, even though the dots themselves can be seen. If codes that are slightly invisible to the eye of a user are printed all over a sheet of paper, the sheet may appear to have a light grey shade if dot patterns printed in black ink are used.* The "substantially invisible" dot codes are herein understood to be visible to *the detector*, rather than *the user*. It is inherent that infrared radiation, whether projected or reflected, is substantially invisible to the user. Silverbrook clearly teaches printing a page with coded data as a collection of tags using invisible ink at 7:38-53. In fact, Applicant's Specification does not even require that a reflection not be visible to be "substantially invisible", as dot

Art Unit: 3714

patterns printed in black ink may appear to a user to have a light gray shade, indicating that the dot pattern is visible to a user, but unintelligible; thus, Applicant's argument is not persuasive.

17. Applicant further states at page 13 that the auditory teaching material, as disclosed by Nagasaki, fails to either teach or suggest instructional response which results from processing the user input, as claimed; thus, the combination of Silverbrook and Nagasaki merely discloses outputting auditory teaching material, which differs from an audio output device for outputting instructional response, as claimed resulting from processing the user input, because the audio information provide auditory teaching material for information that was previously encoded onto a sheet of paper during manufacturing, and is not an instructional response resulting from a user input, as claimed. However, it is irrelevant whether information was previously encoded on a sheet of paper. Silverbrook teaches where a pen device is operated by a user to produce an instructional response (for completing an examination, 47:4-8), and where the instructional responses are output (by printing the examination, 48:1-6). Silverbrook does not teach audio output of the user's response, however, the test for obviousness is not whether the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the instant case, Nagasaki teaches where a loudspeaker in a pen device reproduces audio when a user traces a dot code (9:60-10:8). The pen device would merely incorporate the audio output features of the pen of Nagasaki. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to generate the audio output in response to a user's instruction, given by tracing a dot code with a pen device, as taught by Nagasaki, using the pen device of Silverbrook, in order to provide the advantage of conveying audio media via a paper document,

Art Unit: 3714

which can be transmitted by a fax machine or printer. Thus, Applicant's argument is not persuasive.

18. Applicant further states at pages 13-14 that Silverbrook is silent as to determining a location of a plurality of print elements on the surface, as claimed, because Silverbrook discloses that the coded data from the form is read and provides control information such that designation by the user causes instructions to be applied to a software running on the computer system (see Silverbrook, col. 3, line 65 to col. 4, line 2), and that Silverbrook merely discloses supplying the control information via coded data. However, Silverbrook clearly teaches a sensing device, configured as a pen, which is designed to physically mark the interactive form as well as enable coded data from the form to be read and transmitted to the computer system (3:58-4:2). Silverbrook further teaches a coded data tag that encodes the unique page on which it appears and its own position on the page (9:62-67). Silverbrook also teaches other print elements, having associated hyperlinks, audio clips, etc. (14:57-15:9). It is understood that these elements' positions are tracked based on the coded data tags they overlay. Thus, Silverbrook indeed teaches where the pen device determines the location of a print element {a data tag} on a page surface {by the position data that it conveys}, and as such anticipates the limitation.

19. In response to applicant's argument at pages 14 that there is no suggestion to combine the Silverbrook and Nagasaki references, because one would not be motivated to have a writing device that comprises an output device where the writing device forms a housing, as claimed; that using a speech output device of Nagasaki does not only fail to serve a constructive purpose since it has no use for an examinee answering questions under exam condition but it would be disruptive to other examinees taking the exam, as the sensing device, as disclosed by Silverbrook, is merely for detecting coded data and transmitting the coded data to a computer

Art Unit: 3714

system where the examiner and/or marker can mark and process the exam; Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Silverbrook teaches the use of the netpage pen by an examination user or a participant in any other netpage activities, educational or otherwise (46:3-7). Silverbrook is understandably not limited to an embodiment of traditional examination in a classroom. There is no suggestion in Silverbrook that disruption to test takers would occur if audio feedback is used in educational activities. Further, Nagasaki teaches a pen device, comprising a writing device and an audio device in the same housing as claimed (10:1-8). Nagasaki clearly teaches where the audio device may be a loud speaker; also, headphones or earphones may be used with the device. It is old and well-known in portable media players, e. g. portable CD players and LCD DVD players, to provide a headphone jack for internalizing the sound output, which automatically mutes the internal speaker, for the purpose of privacy and courtesy. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of invention to use the pen device as in Nagasaki, having an audio device and a writing device in a housing, in the system and method of Silverbrook, in order to increase the privacy level of the audio. To wit, Nagasaki teaches using earphones because they are detachable (16:16-27). However, it is common knowledge to use earphones to avoid disturbing one's neighbors. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

Art Unit: 3714

See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Thus, the argument is not convincing.

20. In response to applicant's argument at pages 14-15 that there is no suggestion to combine the Silverbrook and Nagasaki references, as Nagasaki discloses providing auditory teaching material and providing audio output that are educational in nature, and fails to either teach or suggest that a task is audibly presented to the user by the audio output device; as a task, as claimed, asks a user to perform an action as dictated by the task. However, Nagasaki teaches an application of the recording of audio information may be fax operating instructions (12:58-13:6). Instruction pertaining to operating a fax is understood to be asking a user to perform an action, as dictated, thus it is a task, as defined. It is irrelevant whether the nature of the task presented is educational. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the audio tag information in the pen of Silverbrook to convey an instructional response in the form of a task to a user, as taught by Nagasaki, in order to provide instructions to a user which can be faxed, listened to, and optionally read. As such, Nagasaki explicitly teaches the limitation, and Applicant's argument is not convincing.

### ***Conclusion***

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 3714

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolai A. Gishnock whose telephone number is (571)272-1420. The examiner can normally be reached on M-F 8:30a-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

4/8/2008  
/N. A. G./  
Examiner, Art Unit 3714

/Ronald Laneau/  
Supervisory Patent Examiner, Art Unit 3714